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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/526,672	03/04/2005	Hisashi Maeshima	3273-0208PUS1	3246

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EXAMINER

SELLERS, ROBERT E

ART UNIT	PAPER NUMBER
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1796

NOTIFICATION DATE	DELIVERY MODE
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04/23/2008

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

Office Action Summary	Application No. 10/526,672	Applicant(s) MAESHIMA ET AL.	
	Examiner Robert Sellers	Art Unit 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) 6-29 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>10 March 2008</u> . | 6) <input type="checkbox"/> Other: ____. |

Claims 6-29 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected inventions, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on November 15, 2007.

The basis for non-statutory obviousness-type double patenting and the text of section 103(a) of Title 35, U.S. Code not included in this action can be found in the non-Final rejection mailed December 10, 2007.

1. Takai et al. Publication No. 2003/0059618 is withdrawn since has been commonly owned with the instant application by Daicel Chemical Industries, LTD at the time the invention was made as stated in the Remarks section of the response filed March 10, 2008 (page 3, the last five lines).

2. Claims 1-5 are provisionally rejected on the ground of non-statutory obviousness-type double patenting as being unpatentable over claim 4 of copending application no. 10/567,253 in view of the following references:

Yur've et al. article as disclosed in HCAPLUS accession no. 1972:526335,
German Patent No. 1,418,465,
Japanese Patent No. 54-3006,
Hau article translation and
Japanese Patent No. 5-239043 (Japanese '043).

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3. Claims 1-5 are provisionally rejected on the ground of non-statutory obviousness-type double patenting as being unpatentable over claims 5 and 6 of copending application no. 10/883,162 in view of the same references listed in previous paragraph 2.

These are provisional obviousness-type double patenting rejections.

4. Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yur've et al. in view of the same references listed in previous paragraph 2.

The rejections are maintained for the reasons of record set forth in the non-Final rejection. The arguments filed March 10, 2008 have been considered but are unpersuasive.

5. The rejections remain applicable without Takai et al. The German patent describes the preparation of peracetic acid containing substantially no water according to claim 2 as acknowledged in the paragraph bridging pages 26-27. Hau et al. reports peracetic acid obtained by oxidizing an aldehyde to eliminate water. Japanese '043 teaches peracetic acid treated with ethyl acetate as required by claim 5.

6. Although the claims of the copending applications denote the bicyclohexyl diepoxide of claimed general formula (I) without a process for its preparation, the secondary references of Yur've et al., Hau and the German and Japanese patents establish the obviousness of producing it via the claimed epoxidation of a bicyclohexyl diene with peracetic acid in order to optimize the selectivity and conversion (Japanese '043) and prevent epoxy group hydrolysis (Hau).

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Sellers whose telephone number is (571) 272-1093. The examiner can normally be reached on Monday to Friday from 9:30 to 6:00. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).

/Robert Sellers/

Robert Sellers
Primary Examiner
Division 1796